APPENDIX.

Opinion of the District Court on the Gaisman Patent in the Hawley Case.

Gillette Safety Razor Co. v. Hawley Hardware Co.

No. 2142.

DISTRICT COURT, D. CONNECTICUT.

July 21, 1932.

THOMAS, District Judge.

The Gaisman Patent.

This patent also describes a safety razor of the "Gillette type." Prior to the patentee's invention, that is, prior to 1922, these razors were so constructed that one of the clamping members, that is to say, either the guard member or the cap, was provided with blade positioning elements—for instance pins, which were designed to project through holes in the blade and into holes in the other clamping member, whereby the blade and the clamping member were maintained in shaving relation. For example, in the "old style" Gillette razor, Plaintiff's Exhibit 9, there are two pins on the underside of the cap which pass through two holes in the blade and project through corresponding holes in the guard member. From the underside of the cap there also extends a screw-threaded spindle which passes through a hole in the blade and through a corresponding hole in the guard member. This spindle, however, has no function in positioning the blade. Its sole purpose is to engage

the handle of the razor for clamping together the cap, the blade, and the guard member. In this old construction the blade has no function whatever in positioning the clamping members in relation to one another. The object of the Gaisman invention is stated to be to provide a safety razor wherein the blade co-operates with the guard member to retain the blade in shaving relation thereto, and the blade also co-operates with the cap to retain the latter in proper relation to the blade for shaving purposes, so that the position of the cap with regard to the guard member is maintained by the blade and not by the co-operation of the guard member and cap as is the case in the "old type" Gillette razor. In carrying out the invention, the guard member and the blade have co-operating means to retain the blade in shaving relation on the guard member. This means is in the form of a noncircular projection 1b on the guard member adapted to enter a noncircular opening 2a in the blade. This opening is centrally disposed in the blade. The cap is provided with projections or pins 6 on its underface which are adapted to enter recesses or notches 2b in the blade ends whereby the blade retains the cap in operative relation to the blade and to the guard member. The pins 6 do not engage the guard member. In addition, the cap is provided with a screw-threaded spindle 4 which passes through the blade and through an opening in the guard projection 1b for engagement with the handle 5 of the razor. The screw-threaded spindle and handle serve to clamp together the cap, blade, and guard member. As will be seen from the foregoing, the blade constitutes the connecting link between the cap and guard member, that is, when the blade is removed from the razor, the cap and guard member are adapted to move in relation to one another both longitudinally and transversely. However, when the blade is interposed between the cap and guard member it aligns the cap and guard member. In the "old style" Gillette razor the coacting pins on the cap and holes in the guard member maintain

these two elements in shaving relation even if the blade is removed from the razor.

It appears from the record that the distance at which the cutting edge of a blade projects beyond the cap and guard member must be kept within certain limits. If the cutting edge projects beyond the cap and guard member more than 8/1000 (.008) of an inch, the user is apt to cut himself. If the blade does not project far enough, it is difficult or even impossible to shave with the razor. It is desirable to maintain blade exposure to 4/1000 (.004) of an inch.

In order to maintain the blade exposure within the limits specified, the blade positioning means of the razor and the cap and guard member aligning means must, obviously, be made with predetermined accuracy, as only certain clearances and manufacturing tolerances are permissible. The sizes of the pins on the underface of the cap of the "old style" Gillette razor are maintained within certain specified limits, and so are the sizes of the diameters of the holes in the blade and in the guard member. The clearances, when the parts are assembled, are the free spaces between the sides of the pins and the holes in the blade or in the guard member. The sizes mentioned above must be made so accurately that the total accumulated errors in manufacture will not exceed 8/1000 (.008) of an inch. It is thus apparent that an accumulated error of 8/1000 (.008) of an inch which is divided between the various elements of the razor demands great accuracy in manufacture, and it is correspondingly true that costs of manufacture increase rapidly as standards of accuracy are raised.

The principal utility of the Gaisman invention lies in the fact that it permits less accurate standards of manufacture while maintaining equal accuracy of positioning the cutting edges of the blade with relation to the cap and guard member of the razor. The accumulated error which is possible in the Gaisman razor is less than the

accumulated error of the "old style" Gillette razor. It appears from the evidence that the Gaisman principle reduces the variation of the blade cutting edge exposure approximately one-third or, if the same tolerance and clearances are maintained, the Gaisman principle improves the average qualities of the razor by about one third.

Plaintiff's witness T. L. Smith, the production engineer, testified that the greater the tolerance, the lower the cost, and that the greater the precision required, the greater is the cost of manufacture. If the tolerances are reduced one-third, the costs would perhaps be doubled (pages 310, 311), and there is no controversion of this testimony in the record. Therefore the effect of the Gaisman invention is either to permit manufacture with less accurate measurements of a razor which will shave satisfactorily or, if the same accuracy is maintained, to produce a more accurate, and therefore a better, shaving instrument.

The invention described and claimed in the Gaisman patent in suit is in a modified form employed in plaintiff's so-called "Good Will" razor, Plaintiff's Exhibit 4. In these razors the guard member is provided with two spaced apart projections instead of the single central projection 1b of the patent, and the notches or cut-out corners of the blade take the place of the notches 2b in the ends of the blade shown in Fig. 7. The function and operation of the elements of the "Good Will" razors are the same as those of the Gaisman patent in suit. Of the so-called "Good Will" razors the plaintiff has sold many millions. The cost of manufacture is comparatively low because greater tolerances and clearances are permissible without sacrificing the shaving qualities of the razor.

The defenses are:

C. Invalidity of the claims in view of the prior art;

D. The defendant's razor blades do not embody the alleged combination of claim 1 in suit;

E. If claim 1 is construed to cover defendant's blade, it is invalid in view of the prior art;

F. Claim 3 is not infringed as a matter of law. Claims 1 and 3 read:

"1. A blade having a non-circular opening substantially centrally disposed to retain the blade in shaving relation to a guard member, said blade having means spaced from said opening to cooperate with a clamping member to retain the latter in shaving relation to the blade independent of the guard member."

"3. A safety razor comprising blade clamping members, a blade, means cooperative between one of said members and said blade to retain the latter in shaving relation to said member, said blade and the other member having cooperative means whereby the blade will retain said member in an operative position respecting the blade, and means to detachably clamp the blade between said members."

C. The Prior Art.

While quite a number of alleged prior art patents have been pleaded by defendant, only four of the same received attention at trial, so this discussion will be limited to the four patents discussed by Mr. Campfield, defendant's expert whose testimony was not directed to the facts. The four patents to be considered are as follows:

1. To Clark, No. 933,020, issued August 31, 1909.
2. To Nahemow, No. 952,837, issued March 22, 1910.
3. To Leslie, No. 1,272,816, issued July 16, 1918.
4. To Gaisman, No. 1,011,938, issued December 19, 1911.

The questions presented, so far as the four prior art patents are concerned, are exceedingly simple and they may be resolved into two: First, do the four prior art patents, either singly or in combination, disclose a safety razor in which a cap is free to move relative to the guard

when the blade is removed from the razor? Second, do these prior art patents describe or illustrate a blade of the "Gillette type" which forms the connecting link between the guard member and cap? The answers to these questions must be in the negative, as will be shown by a discussion of the patents.

The Clark Patent No. 933,020.

This patent shows a razor of the "Gillette" type with a positive connection between the cap and the guard member. From the blade contacting face of the guard extends a projection 15 adapted to enter a performation 14 in the blade and recesses 21 in the cap. Therefore the cap is positively positioned with relation to the guard just as the cap in the "old style" Gillette razor is positioned by its pins with reference to the guard. This razor is exactly like the "old style" Gillette. It does not embody the Gaisman invention. It accumulates the manufacturing errors and it fails to eliminate them.

The Nahemow Patent No. 952,837.

This patent also shows a razor of the old "Gillette type." The guard is made of two pieces which are adjustable to vary its width. The cap has a screw-threaded shank 20 which is provided with an enlarged angular head 21 at its inner end to fit the opening 15 in the guard and the central angular opening in the blade marked 26. All that has been said about the Clark patent applies also to this patent.

The Leslie Patent No. 1,272,816.

Defendant's expert relies particularly on this patent. It discloses a razor which is provided with two blades both of which are flat and, as stated in the specification, "thin yet stiff." The claims, too, call for "a substantially non-flexible blade." It must be remembered that Gaisman

provides a flexible blade in contrast to the non-flexible blade shown and described in the Leslie patent, in which patent the cap is positioned by the guard and the blade has nothing whatever to do with the positioning of the cap in relation to the guard.

The Prior Gaisman Patent, No. 1,011,938.

This patent discloses a blade having three polygonal openings corresponding to the three openings of the "old style" Gillette blade. No mention whatever is made in this patent of the features which are characteristic of and described and claimed in the Gaisman patent in suit. Hence I conclude that the prior art cited and relied upon by defendant cannot invalidate claims 1 and 4 of the Gaisman patent in suit.

The Canadian Judgment.

[5] Subsequent to the final hearing, defendant filed with the court a certified copy of an opinion rendered by the Exchequer Court of Canada on May 27, 1932, in a suit brought for the infringement of a Canadian patent by Gillette Safety Razor Company of Canada, Limited, *v.* Pal Blade Corporation, Limited, and Metropolitan Stores, Limited, alleging that the Canadian suit was founded on the Canadian patent corresponding to the Gaisman patent involved in the case at bar. It appears from this judgment that claim 4 of the Canadian patent is the same as claim 1 of the Gaisman patent in suit and that claim 4 was held invalid by Judge MacLean. There is nothing, however, in this record or in anything submitted after final hearing which shows that the Canadian case was presented and considered by the court upon the same record as the one which has been made in the case at bar. In any event, even though we indulge in the violent presumption that the record there was the same as the

record here, I should not feel inclined to surrender my own judgment and the conclusions herein reached and stated upon the issues herein presented. If the record there was the same as the record here, I should, with all due respect for the judgment of the Canadian court, dissent from the opinion filed by Judge MacLean. Comity is not a rule of law, but one of practice, convenience, and expediency. It requires of no court to abdicate its individual judgment, and is applicable only where, in its own mind, there may be a doubt as to the soundness of its views. This principle is clearly stated by Mr. Justice Brown in Mast, Foos & Co. *v.* Stover Manufacturing Co., 177 U. S. 485, at page 488, 20 S. Ct. 708, 710, 44 L. Ed. 856, where he said: "Comity persuades; but it does not command. It declares not how a case shall be decided, but how it may with propriety be decided. It recognizes the fact that the primary duty of every court is to dispose of cases according to the law and the facts; in a word, to decide them right. In doing so, the judge is bound to determine them according to his own convictions. If he be clear in those convictions, he should follow them. It is only in cases where, in his own mind, there may be a doubt as to the soundness of his views that comity comes in play and suggests a uniformity of ruling to avoid confusion, until a higher court has settled the law. It demands of no one that he shall abdicate his individual judgment, but only that deference shall be paid to the judgments of other co-ordinate tribunals. Clearly it applies only to questions which have been actually decided, and which arose under the same facts."

D. Defendant's Blades Do Not Embody Combination of Claim 1.

[6] As a further defense it is urged by the defendant that its razor blades, Plaintiff's Exhibit 6, neither embody the structure defined in claim 1 of the Gaisman patent nor

perform the function specified therein. This contention is based, as I view it, upon a complete misunderstanding of the Gaisman patent by defendant's expert and on the wrong assumption that Plaintiff's Exhibit 3, bar type razor, is made in accordance with the Gaisman patent in suit. As appears very clearly from plaintiff's proofs, it is its own good will razor, Plaintiff's Exhibit 4, which is constructed according to the teachings of the Gaisman patent.

Claim 1 of the Gaisman patent specifies:

1. "A non-circular opening substantially centrally disposed" having the function of retaining the blade in shaving relation to a guard member; and

2. "Means spaced from said opening," that is, the recesses or notches 2b in the ends of the blade, the function of which is "to cooperate with a clamping member (the cap) to retain the latter (the cap) in shaving relation to the blade independent of the guard member."

In other words, this claim covers a razor blade having two characteristics—one of which is a central opening for positioning the blade on the guard member, and the other the notches in the ends of the blade to locate the cap on the blade. Defendant's Clark Ace blade, Plaintiff's Exhibit 6, embodies the two essential elements of claim 1 and has their functions. The Ace blade has a noncircular opening in the form of a slot which is centrally disposed in the blade in the respect that it is located in the longitudinal axis of the blade. This slot serves to retain the blade in shaving relation to the guard member as may be readily ascertained by placing the blade on the guard of a good will razor, Plaintiff's Exhibit 4. It also has "means" (the notches or recesses in the four corners of the blade) "spaced from said opening," and these notches "cooperate with a clamping member (the cap) to retain the latter in shaving relation to the blade independent of

the guard member," as may be readily seen by mounting the blade on the cap of a good will razor, Plaintiff's Exhibit 4. An inspection of the good will razor with a Clark Ace blade mounted thereon clearly discloses the fact that the blade forms the connecting link between the cap and the guard member, which otherwise are free to move both longitudinally and laterally with respect to each other.

Defendant argues that its Clark Ace blade does not include a noncircular opening substantially centrally disposed to retain the blade in shaving relation to the guard member, because the guard members of the Gillette good will razors are not provided with any projection whatsoever upon which the noncircular centrally disposed (square) opening of the defendant's blade can fit, and that there are no projections on the cap of the Gillette good will razor which could be construed as a substitute or equivalent of the diamond shaped snugly fitting projection 1b of the Gaisman patent. There is no merit in this contention. The Gillette good will razor has two diamond-shaped projections on its guard which fit into the centrally disposed noncircular slot in the Clark Ace blade and thereby retain the blade in shaving relation to the guard member.

Defendant further argues that the parts of the razor of the Gaisman patent in suit are not "in shaving relation" until the handle has been screwed down and has caused the cap and the guard member to flex and then clamp the blade between them. This argument is based upon a misunderstanding of the term "shaving relation." When the parts of the Gaisman razor are assembled with the blade between them, and before the handle is screwed down to clamp the parts together, the blade is in shaving relation with respect to the guard member and the cap is in shaving relation to the blade independent of the guard member. The parts, however, are not in shaving position, meaning thereby that the blade has not yet been flexed. Inasmuch as the claim does not call for shaving position,

but only for shaving relation, it is evident that defendant's argument is not well taken.

In view of the foregoing, I conclude and hold that Plaintiff's Exhibit 6, Clark Ace blades, infringe claim 1 of the Gaisman patent in suit.

E. If Claim 1 is Construed to Cover Defendant's Blade, it is Invalid in View of the Prior Art.

As a further defense it is asserted by defendant that if claim 1 of the Gaisman patent in suit is construed to cover defendant's blade, it is invalid in view of the prior art. All the argument on this point is based upon the fact that some of the prior art patents show noncircular centrally disposed positioning openings and on the assumption that the noncircular positioning opening in the Gaisman blade does not retain the blade in shaving relation to a guard member, and on the further allegation that notches or recesses in blades are old for co-operation with one of the clamping members of a razor.

It appears from the discussion of the prior art, *supra,* that the blades disclosed in the patents relied on by the defendant do not and cannot function in the manner called for by claim 1 of the Gaisman patent in suit. It is also apparent that the noncircular central opening in the Gaisman blade has the function of retaining the blade in shaving relation to a guard member. Nevertheless, even if every element of the combination defined by claim 1 of the Gaisman patent was old, the claim would be valid because it is a general rule that a patentable invention may consist entirely in a new combination or arrangement of old and well-known elements or ingredients provided a new and useful result is thereby attained. Inasmuch as the result obtained by Gaisman is new and useful, it follows that claim 1 is valid. This doctrine is clearly stated by Judge Thayer, speaking for the Circuit Court of Appeals, Eighth Circuit, in Fairbanks, Morse & Co. *v.* Stickney,

123 F. 79, at page 82, where he said: "Even if it be conceded that the individual elements composing the combination are to be found in the prior art, yet, to make the selection of these parts from the prior art, and to combine them, as Hobart did, so as to produce a clutch which is at the same time, simple, compact, effective, and useful, required, as we think, more than ordinary mechanical skill."

[7] It is not of consequence that the elements of each claim may be old, for the claims are for a combination, and if the combination is new, or if by a new method of organization new or better results are obtained, the patent may be sustained. Dunn Mfg. Co. *v.* Standard Computing Scale Co., 163 F. 521 (Circuit Court of Appeals, Sixth Circuit); Davis *v.* Perry (C. C. A.) 120 F. 941; Brown *v.* Huntington Piano Co. (C. C. A.) 134 F. 735; Hobbs Mfg. Co. *v.* Gooding (C. C. A.) 111 F. 403, 406; Dececo Co. *v.* George E. Gilchrist Co. (C. C. A.) 125 F. 293, 298, 299; Western Electric Co. *v.* North Electric Co. (C. C. A.) 135 F. 79, 89; Sanders *v.* Hancock (C. C. A.) 128 F. 424, 433, 434.

[8] The fact that all of the elements of a combination may be found in the prior art and apparently in combination in the claims of prior patents does not anticipate unless, when read in connection with the specification of the patent in suit, the structure and function of the invention appears. Warren Steam Pump Co. *v.* Blake & Knowles Steam Pump Works, 163 F. 263 (Circuit Court of Appeals, First Circuit). For the reasons given I conclude that the defenses interposed cannot prevail.